

## **REMARKS / ARGUMENTS**

### **I. General Remarks and Disposition of the Claims**

Please consider the application in view of the following remarks. Applicants thank the Examiner for his careful consideration of this application., including the references Applicants have submitted in this application and, pursuant to Manual of Patent Examining Procedure (MPEP) § 609.02, all references submitted in the patent application to which this application claims priority under 35 U.S.C. § 120.

At the time of the Final Office Action, claims 1-38 were pending in this application. Claims 7 and 11-38 were withdrawn from consideration. Claims 1-6 and 8-10 were rejected in the Final Office Action. In this response, claims 1 and 8 have been amended. These amendments are support by the specification as filed. It should not be assumed that the amendments were made for reasons related to patentability.

Applicants respectfully request that the above amendments be entered and further request reconsideration in light of the amendments and remarks contained herein.

### **II. Remarks Regarding Rejection Under 35 U.S.C. § 102**

Claims 1-6 and 8-10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2003/0013871 to Mallon *et al.* (hereinafter "*Mallon*"). With respect to this rejection, the Final Office Action states:

Applicant's arguments in Response with respect to the 35 U.S.C. 102(b) rejection of claims 1-6 and 8-10 as anticipated by Mallon have been fully considered but deemed unpersuasive.

Applicant's primary argument in Response traversing the captioned rejection is that Mallon does not disclose the alkyl side chain of its polymer having the same number of carbons as the polymer of the present invention. Particularly, Applicant states:

"... [W]ith respect to independent claim 1, Mallon fails to disclose "a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer." Although *Mallon may disclose reacting chitosan with a salt having up to three carbons*, Mallon fails to disclose a "hydrophobically modified" polymer as defined by Applicants . . . *Applicants have defined* "hydrophobically modified" to refer to the incorporation into the hydrophilic polymer structure of hydrophobic groups, wherein *the alkyl chain*

*length is from about 4 to about 22 carbons. (See Specification, ¶ [0018]) . . . As the . . . hydrophobic compounds of Mallon comprise up to three carbons, their incorporation into a hydrophilic polymer would not constitute hydrophobic modification. See Mallon, ¶ [0018] . . . Therefore, Applicants respectfully submit that Mallon fails to disclose a water-soluble relative permeability modifier that comprises a hydrophobically modified polymer. As such, the cited reference does not anticipate this claim.” [Emphasis added by Examiner.]*

That is, Applicant alleges that the polymer disclosed in Mallon does not anticipate the polymer component of the relative permeability modifier recited in independent claim 1 because its alkyl chain has 3 carbons whereas that of the present invention has “about 4 to about 22 carbons” (as defined in the cited paragraph of the present specification and recited in instant claim 8). This argument has been determined unpersuasive because the first endpoint of the recited range disclosed in the specification cited by Applicant (“about 4 carbons”) must encompass an alkyl chain having three carbons. Because a range of carbons numbers for an alkyl chain must all be integers (a side chain can not contain an alkyl chain having a length of, for example, 3 and a half carbons), the term “about” implies that three carbons may anticipate this range limitation of the claim. Otherwise, the term “about” in the present claims would be superfluous.

Moreover, *assuming arguendo*, in accordance with the doctrine of claim differentiation, dependent claim 8 would not be further limiting because it recites the same exact range of carbon numbers for the alkyl side chain that Applicant now alleges is implicit in independent claim 1.

Furthermore, as to claims 1-6, 9 and 10 specifically, it is noted that this range limitation for the alkyl chain that Applicant relies upon is not recited in these rejected claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 2057 (Fed. Cir. 1993).

Thus, the instant claims, as amended, remain anticipated by Mallon.

(Final Office Action at 2-4.)

In response to Applicants’ arguments filed on February 23, 2009, the Advisory Action states:

The request for reconsideration has been considered but does NOT place the application in condition for allowance because: Mallon anticipates the claims for the same reason previously made of record in item 3 on page 2 of the Final Rejection dated December 12, 2008 (hereinafter 'FOA'. As stated previously in FOA, assuming *arguendo* that Mallon only discloses hydrophobic alkyl chains up to three carbons, it still anticipates the present claims because Applicant's definition of hydrophobic chain (claim 8) is having a number of carbons "about 4 to about 22" carbons. "About 4" must encompass at least three carbons because this range of carbons is a range of integers. Otherwise, the term "about" would be superfluous. In addition, it is extremely unclear as to why the three carbon carboxylate chains disclosed in Mallon that are cited by Applicant on page 10 would not be hydrophobic in nature.

(Advisory Action at 2.) Applicants respectfully disagree. Applicants respectfully submit that the cited reference does not disclose each and every limitation of claims 1-6 and 8-10 as required to anticipate these claims under 35 U.S.C. § 102(b). *See* MPEP § 2131.

In particular, with respect to independent claim 1, *Mallon* fails to disclose a hydrophobically modified polymer that comprises "a hydrophobic group that comprises an alkyl chain of from 4 to about 22 carbons." Although *Mallon* may disclose reacting chitosan with a salt, *Mallon* fails to disclose a reacting chitosan with an alkyl chain of from 4 to 22 carbons. Rather, the alleged hydrophobic compounds of *Mallon* comprise up to three carbons, and do not comprise from 4 to 22 carbons. *See Mallon*, ¶ [0018] ("In addition, 'base' and 'salt,' as used herein, refer to the hydroxides, chlorides, carbonates or lower carboxylates having up to 3 carbons."). Therefore, Applicants respectfully submit that *Mallon* fails to disclose hydrophobically modified polymer that comprises a hydrophobic group that comprises an alkyl chain of from 4 to 22 carbons. As such, the cited reference does not anticipate this claim.

Therefore, Applicants respectfully assert that independent claim 1 and its dependent claims are not anticipated by *Mallon*. Accordingly, Applicants respectfully request withdrawal of this rejection with respect to claims 1-6 and 8-10.

### III. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to

additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art.

**SUMMARY AND PETITION  
FOR ONE-MONTH EXTENSION OF TIME**

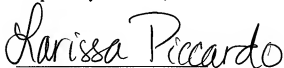
In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants have authorized the Commissioner via the Office's electronic filing system to debit Baker Botts L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0411, in the amount of \$810.00 for the RCE fee under 37 C.F.R. § 1.17(e).

Applicants hereby petition for a one-month extension of time to file this response under 37 C.F.R. § 1.136(a), extending the deadline from March 17, 2009 to April 17, 2009. Accordingly, Applicants have authorized via the Office's electronic filing system the Commissioner to debit the deposit Account of Baker Botts L.L.P., Deposit Account No. 02-0383, Order Number 063718.0411, in the amount of \$130.00 under 37 C.F.R. § 1.17(a)(1) for the one-month extension of time, extending the period to reply up to and including April 17, 2009.

Applicants believe that no other fees are due in association with the filing of this response. Should the Commissioner deem that any additional fees are due, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to Baker Botts, L.L.P.'s Deposit Account No. 02-0383, Order Number 063718.0411.

Respectfully submitted,

A handwritten signature in black ink that reads "Larissa Piccardo". The signature is fluid and cursive, with the first name and last name clearly distinguishable.

Larissa Piccardo  
Registration No. 60,448  
BAKER BOTTS L.L.P.  
One Shell Plaza  
910 Louisiana  
Houston, TX 77002  
Telephone: 713.229.1465  
Facsimile: 713.229.7765  
Email: [larissa.piccardo@bakerbotts.com](mailto:larissa.piccardo@bakerbotts.com)

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